GP2877

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Nobuaki EMA
Serial No. : 09/933,691
Filed : August 21, 2001
Title : OPTICAL COMPONENT MEASUREMENT APPARATUS AND METHOD OF TESTING OPTICAL COMPONENT

Art Unit : 2877
Examiner : Gordon J. Stock, Jr.

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY TO ACTION OF JULY 13, 2004

An Information Disclosure Statement, including a form 1449 that listed the cited references, was filed with applicant's Reply to an earlier Office action on about May 28, 2004. Applicant respectfully requests that the Examiner mail an initialed copy of that form 1449 to indicate the Examiner's consideration of the listed information.

The Notice of References Cited that accompanied the Office action of July 13, 2004 lists "JP 01025019 A" as one of the cited references. It appears that the correct publication number for that reference is "JP 64-25109." Applicant requests a corrected Notice of References Cited.

In the present Office action, claims 1 and 5 were rejected as anticipated by U.S. Patent No. 6,480,651 (Rabinski).

In a previous Reply, the applicant addressed that patent and explained that it is not prior art with respect to the pending claims:

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Oct. 13, 2004
Date of Deposit

Paula T. Romeo
Signature

PAULA T. ROMEO
Typed or Printed Name of Person Signing Certificate

> The Rabinski patent has a US filing date of July 13, 2001 and an issue date of November 12, 2002. The present application has US filing date of August 21, 2001 which is later than the US filing date of the Rabinski patent (July 13, 2001). However, the present application has a foreign priority date of August 31, 2000 which is earlier than the US filing date of the Rabinski patent (July 13, 2001). Thus, the Rabinski patent is not a valid prior art reference. . . .
>
> If the Examiner requires the submission of a certified English translation of the priority document for the present application along with a statement indicating the accuracy of the translation, we will provide such documents.

(Reply, May 13, 2003, pages 5-6)

The current Office action now states that the applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of the priority papers has not been made of record.

Enclosed with this Reply is an English-language translation of the foreign priority document with a certification that the translation is accurate. Accordingly, applicant respectfully requests withdrawal of the rejection of the claims based on the Rabinsky patent.

Applicant does not concede that there are no other grounds for distinguishing the Rabinsky patent from the pending claims. However, since the applicant's reliance on the foreign priority date is sufficient to remove the Rabinsky patent as a reference against the pending claims, further discussion of the Rabinsky patent is not required.

Claims 1 and 5 also were rejected as unpatentable over the combination of the (i) the applicant's admitted prior art, (ii) U.S. Patent 5,754,721 (Pan), (iii) JP 64-025109, and (iv) U.S. Patent No. 5,889,586 (Chauvin et al.). In particular, the conclusion of obviousness under 35 U.S.C. § 103 is based on (1) the applicant's acknowledged prior art in the Background section of the specification, (2) the three additional references listed above, and (3) a general statement that "display units are well known in the art" (*see* Office action at page 4, second paragraph). As discussed below, applicant respectfully disagrees.

The conclusion is based on improper hindsight which uses the applicant's own specification as a blueprint for selectively piecing together features from different sources to reconstruct the claimed invention. The Office action fails to point to anything that would have motivated a person of ordinary skill in the art to combine the cited references as suggested by the Examiner. (*See* the discussion on The Law of Obviousness at pages 2-3 of applicant's Reply, dated May 28, 2004. That discussion is incorporated herein.)

For example, the problem addressed by the applicant relates to measuring a wavelength dependent characteristic of an optical device (page 1, lines 20-21). The applicant noted that, in a prior technique:

> [W]hen the device 105 is a multiple terminal device having a plurality of output terminals, an optical power meter must be prepared for each of the terminals, or the measurement optical fibers must be connected to one terminal after another. Thus, a measurement preparation time is lengthened, thereby requiring expense in effort.

(Page 3, lines 1-6) As a result of applicant's invention:

> When a device under test has a plurality of output terminals, photodetectors can be connected to corresponding output terminals beforehand. Hence, there is obviated a necessity of changing connections to the output terminals every time measurement is performed, thus saving labor and shortening working hours.

(Page 6, lines 7-12)

In contrast, the problem addressed by JP 64-025109 (=JP 01-025109) relates to an automatic alignment device. Although applicant's admitted prior art (FIG. 3) illustrates alignment control, the problem addressed by the applicant does not relate to that aspect of the system. Therefore, there would have been no motivation to modify applicant's admitted prior art (FIG. 3) according to the disclosure of JP 64-025109.

The Chauvin et al. patent relates to analyzing a luminous flux. The Office action refers to col. 1, lines 9-15. In the type of multichannel photodetection system discussed in the Background section of that patent, each photodetector receives a portion of the luminous flux

coming from one of various adjacent zones in a line so that the entire luminous flux can be analyzed. That has nothing to do with the subject matter of the pending application. Furthermore, the Chauvin et al. patent criticizes that type of photodetection system (col. 1, lines 27-30). At least for those reasons, a person of ordinary skill would not have been motivated to modify applicant's FIG. 3 to incorporate the techniques of the Chauvin et al. patent in the manner suggested by the Office action.

In view of the foregoing remarks, applicant submits that the required "clear and particular" motivation to combine the disclosures of the various references is lacking. A contrary conclusion would be based on precisely the type of improper hindsight the Federal Circuit has warned against.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Applicant notes that this is the fourth Office action and thanks the Examiner for the careful attention to the pending claims. Applicant respectfully requests allowance of the claims.

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: 10/13/04

Samuel Borodach
Reg. No. 38,388

Fish & Richardson P.C.
Citigroup Center
52nd Floor
153 East 53rd Street
New York, New York 10022-4611
Telephone: (212) 765-5070
Facsimile: (212) 258-2291

30205882.doc